



hQ
12-10-03
#16

Patent
Attorney's Docket No. 033275-015

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of)
Rainer HÖCKER et al.) Group Art Unit: 3743
Application No.: 10/002,633) Examiner: L. Leo
Filed: December 5, 2001) Confirmation No.: 4154
For: WALL PART ACTED UPON BY)
AN IMPINGEMENT FLOW)

REPLY BRIEF

BURNS, DOANE, SWECKER & MATHIS, L.L.P.
P.O. Box 1404
Alexandria, VA 22313-1404
(703) 836-6620



Application No. 10/002,633
Attorney's Docket No. 033275-015

REPLY TO EXAMINER'S ANSWER

A. Cermak Does Not Disclose the Claimed Invention

The Examiner incorrectly interprets the claim recitation "similar rotationally symmetrical forms" to include the cylindrical pockets described in *Cermak*. However, this recitation must be interpreted in light of the specification. As clearly stated in the specification, the troughs defined in the present invention provide an advantage over "known elements having areas running perpendicular to the wall". See page 7, lines 7-10 of the present invention. The cylindrical pockets of *Cermak* run perpendicular to the wall, as thus, can not be read as similar rotationally symmetrical troughs. The Examiner has simply ignored this argument, and has not provided any reasoning or support as to how or why the term "similar rotationally symmetrical forms" should be read to include cylindrical pockets. As such, the Examiner has failed to establish that the claimed invention lacks novelty over *Cermak*.

B. The Combination of *Cermak* and *Ashiwake et al.* is Hindsight

The Examiner again attempts to combine the two references while recognizing that "the environments of *Cermak* and *Ashiwake et al* may be different." See page 6 of the Examiner's Answer. Still, the Examiner maintains his position that the references are combinable, apparently because "[b]oth disclosures are pertinent to the claimed invention and seek to solve a common problem with a common structure". *Id.* However, this alleged commonality is not enough to establish a *prima facie* case of obviousness.

The Federal Circuit has recently stressed that "[o]ur case law makes *clear* that the

RECEIVED

-1-

DEC 04 2003

TECHNOLOGY CENTER R3700

best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is vigorous application of requirement for a showing of the teaching or motivation to combine prior art references". *In re Dembiczkak*, 50 U.S.P.Q. 2d 1614, 1617 (Fed. Cir. 1999) (emphasis added). The Federal Circuit requires that the "showing ... be clear and particular." *Id.* "Broad conclusory statements regarding the teaching of multiple references, standing alone, are not 'evidence'". *Id.*

not explicitly ordinary skill

This is precisely the case in the present matter. The Examiner has failed to point to specific information in either reference which would suggest the combination between the two references. The Examiner points to no factual basis for combining the two references. The Examiner only makes the broad conclusory statement that "[b]oth disclosures are pertinent to the claimed invention and seek to solve a common problem with a common structure". As such, the Examiner fails to make any "particular findings regarding the locus of the suggestion, teaching, or motivation to combine the prior art references", as specifically required by the Federal Circuit. *Id.*

As stated in Appellants' Appeal Brief, *Cermak* and *Ashiwake et al.* are not from the same field of endeavor, and one having ordinary skill in the art would not be motivated to combine the two references in the manner suggested by the Examiner. See Pages 10-11 of Appellants' Appeal Brief. The Examiner has not provided sufficient reasoning as to why the references would be combinable by one having ordinary skill in the art. Therefore, the Examiner has failed to establish a *prima facie* case of obviousness.

C. The Combination of *Wettstein* and *Livingood et al.* is Inappropriate

The Examiner ignores the Appellants' position regarding why *Wettstein* or *Livingood et al.* are not properly combinable. Instead, the Examiner accuses the Appellants of "downplaying" the level of skill in the art. See page 8 of the Examiner's Answer. This is not the case. In fact, the Appellants, who have ordinary skill in the art, set forth reasoning as to why someone having ordinary skill in the art would not combine the references, not that the level of ordinary skill in the art is low. See page 11-14 of the Appeal Brief. The Examiner has ignored this argument.

Again, the Examiner has failed to establish the proper factual basis for combining the two references. Instead, the Examiner states that "Livingood et al and Wettstein are both related to jet impingement cooling of the internal surface of turbine vanes or blades", but does not provide the proper factual basis as to why the references would be combined in the manner suggested by the Examiner. As such, the Examiner's rejection of the claims over *Wettstein* and *Livingood et al.* is nothing more than hindsight, once again.

Application No. 10/002,633
Attorney's Docket No. 033275-015

II. **CONCLUSION**

For at least the reasons set forth above, it is respectfully submitted that the rejections of Claims 1-2 and 5-6 are improper and should be reversed.

Respectfully submitted,

BURNS, DOANE, SWECKER & MATHIS, L.L.P.

By: 
Elaine P. Spector
Registration No. 40,116

P.O. Box 1404
Alexandria, Virginia 22313-1404
(703) 836-6620

Date: December 1, 2003